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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

William J. BAER, et al.

Appln. No.: 09/489,143

Confirmation No.: 5414

Filed: January 21, 2000

Docket No: A8521

Group Art Unit: 2176

Examiner: Peter J. SMITH

For: METHOD AND SYSTEM FOR CALCULATING COST OF A COMPILATION OF
CONTENT

SUBMISSION OF APPEAL BRIEF

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith please find an Appeal Brief. A check for the statutory fee of $500.00
is attached. The USPTO is directed and authorized to charge all required fees, except for the
Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any
overpayments to said Deposit Account. A duplicate copy of this paper is attached.

Respectfully submitted,

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WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: August 2, 2005

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Appln. No.: 09/489,143	Group Art Unit: 2176
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For: METHOD AND SYSTEM FOR CALCULATING COST OF A COMPILATION OF CONTENT

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

Table of Contents

I.   REAL PARTY IN INTEREST

The real party in interest in this appeal is International Business Machines Corporation

("IBM") of Armonk, New York, the assignee.

II.   RELATED APPEALS AND INTERFERENCES

The following applications are the subject of a prior or pending appeal, are related to the present application on appeal, and may directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

- U.S. Application No. 09/488,969:   Notice of Appeal filed April 28, 2005; Appeal Brief filed June 28, 2005.

- U.S. Application No. 09/489,561:   Notice of Appeal filed January 18, 2005; finality of the rejections was withdrawn and a Notice of Allowance mailed on April 27, 2005.

- U.S. Application No. 09/489,605:   Notice of Appeal filed January 22, 2003; Appeal Brief filed March 24, 2003; and a Notice of Allowance mailed on April 27, 2005.

There are no other appeals or interferences known to Appellant, Appellant's legal representative, or the assignee that will directly affect or be directly affected by, or have a bearing on, the Board's decision in this appeal.

APPEAL BRIEF UNDER 37 C.F.R. § 41.37
Appln. No.: 09/489,143

Attorney Docket No.: A8521

III.   STATUS OF CLAIMS

Claims 1-27 are pending in the present application and stand rejected.

Claims 1-2, 9-10 and 17-18 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,768,521 to Dedrick.

Claims 3-6, 11-14, 19-22 and 25-27 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Dedrick.

Claims 7-8, 15-16 and 23-24 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Dedrick in view of U.S. Patent No. 6,199,054 to Khan et al.

A copy of the claims on appeal is set forth in an attached Appendix.

IV.   STATUS OF AMENDMENTS

Amendments to the claims were submitted in an Amendment Under 37 C.F.R. § 1.111 filed

December 14, 2004. All amendments are believed to have been previously entered and made of

record. A Response under 37 C.F.R. § 1.116 was filed on May 2, 2005, in response to the Final

Office Action dated March 2, 2005. In an Advisory Action dated May 13, 2005, the Examiner

states that the Response filed May 2, 2005, has been considered but did not place the application

in a condition for allowance.

V.   SUMMARY OF THE CLAIMED SUBJECT MATTER

Appellant's invention as recited in, for example, independent claims 1, 9 and 17, is

related to methods, program storage devices, and systems for determining the cost of a content

object having a plurality of content entities.

Content management systems such as relational databases, digital libraries, and media

servers have enabled contents of all types to be stored digitally. Content management systems

also have functions for manipulating the stored content. An exemplary embodiment of the

present invention permits a user to take advantage of vast stores of content to create compilations

tailored to the user's needs or desires. See page 1 of Appellants's specification.

Claim 1

A method for determining the cost of a content object having a plurality of content

entities (see e.g. EProductGetOutline function as described on page 91 of Applicant's

specification), comprising the steps of determining a content count (e.g. Section/UPM Page

Count, Chapter/UPM Page Count, Volume Page Count, Book Page Count) for the content object

(e.g. Content Book Outline) and determining from the content count a price for the content

object. See page 91-96 of Appellant's specification; Figs. 19, 20A, and 20B; see also 10A, 10B,

12, 13, 15A, 16, 17, 20C and 21B.

Claim 9

A program storage device readable by a machine, tangibly embodying a program of

instructions (see e.g. EProductGetOutline function as described on page 91 of Applicant's

specification), executable by the machine to perform method steps for determining the cost of a

content object (e.g. Content Book Outline) having a plurality of content entities, comprising the

steps of determining a content count (e.g. Section/UPM Page Count, Chapter/UPM Page Count,

Volume Page Count, Book Page Count) for the content object and determining from the content

count a price for the content object. See page 91-96 of Appellant's specification; Figs. 19, 20A,

and 20B; see also 10A, 10B, 12, 13, 15A, 16, 17, 20C and 21B.

Claim 17

A system for determining the cost of a content object (Custom Book Outline) having a

plurality of content entities, comprising means for determining a content count (e.g.

Section/UPM Page Count, Chapter/UPM Page Count, Volume Page Count, Book Page Count)

for the content object (performed by EProductGetOutline and CBO routines using a set of

algorithms against state stored in the digital library, see page 91, lines 1-6 of Appellant's

specification), and means for determining a price for the content object from the content count.

See page 91-96 of Appellant's specification; Figs. 19, 20A, and 20B; see also 10A, 10B, 12, 13,

15A, 16, 17, 20C and 21B.

VI.   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1.   Claims 1-2, 9-10 and 17-18 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Dedrick (U.S. Patent No. 5,768,521).

2.   Claims 3-6, 11-14, 19-22 and 25-27 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Dedrick.

3.   Claims 7-8, 15-16 and 23-24 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Dedrick in view of Khan et al. (U.S. Patent No. 6,199,054).

VII.   ARGUMENT

1.   Claims 1-2, 9-10 and 17-18 are patentable over Dedrick

As noted above, claims 1-2, 9-10 and 17-18 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Dedrick. It is respectfully submitted that claims 1-2, 9-10 and 17-18 are patentable over Dedrick for at least the following reasons.

Claims 1-2, 9-10 and 17-18

Claim 1 recites:

> "A method for determining the cost of a **content object** having a plurality of content entities, comprising the steps of determining a **content count** for the content object and determining from the content count a price for the content object."

Dedrick discloses a general purpose metering mechanism for the distribution of electronic information from a server to a client computer.   Content in a database such as newspapers and magazines can be provided from a publisher to a user for a predetermined cost. A client is charged according to a metering mechanism which meters the flow of information to a client computer. Col. 1, lines 62-65.

The Examiner asserts that Dedrick col. 1, line 62-col. 2, line 22 and col. 4, line 26-col. 5, line 25 teaches all the elements of claim 1. The respective column and lines cited by the Examiner describe a metering mechanism which meters the flow of information from a server to a client computer. That portion of Dedrick discloses that a client can be charged for the services monthly, yearly, a one time charge, pay per view, per byte, or per time.

Claim 1 recites "a method for determining the cost of a content object having a plurality of content entities." The Examiner asserts that Dedrick discloses a database that corresponds to the claimed content object and that the units of information (i.e. text, video, advertisements) disclosed in Dedrick corresponds to the claimed plurality of content entities.

Claim 1 further recites "determining a *content count* for the content object." The Examiner asserts that Dedrick "counts" the units of the content object in order to calculate a cost to charge the user. In order to anticipate the claims, the Examiner must establish that each and every element is disclosed in the cited art. However, Appellant respectfully submits that the Examiner has failed to identify where a "count" is disclosed in Dedrick.

Dedrick discloses calculating a cost per view, per byte or per time. Dedrick does not disclose determining a content count for a content object. In Dedrick, the user is charged for the units of information selected from the database. There is no indication that a count of the contents in the database is performed.

Claim 1 further recites "determining from the content count a price for the content object." As previously indicated, the user is charged for the units of information retrieved from the database. It is respectfully submitted that Dedrick does not disclose determining a price for a content object according to a *content count*.

The Examiner appears to concede that Dedrick does not explicitly disclose determining a price for a content object according to a *content count*, and asserts that determining a price for a content object according to a content count is inherent in Dedrick. In particular, in the Advisory Action dated May 13, 20005, the Examiner states:

> "The Examiner finds it highly unlikely that Dedrick
> would restrict a user to acquire only one unit of
> information at a time in the case of the "per byte"
> and "per time" pricing. If single unit acquisition
> was in fact implemented and the user wanted to acquire
> a 5MB file in a price per MB pricing scheme, the user
> would have to make five separate requests to acquire
> one single file."

However, the Examiner's own statement contradicts the Examiner's inherency argument. In relying upon the theory of inherency, the Examiner must show that the allegedly inherent characteristic *necessarily flows* from the teachings of the applied prior art. However, the Examiner admits in the Advisory Action that single unit acquisition could be implemented although it would require a user to make several separate requests. Consequently, it is not inherent that Dedrick determines from the content count a price for the content object, since separate single unit requests are possible.

Because Dedrick fails to disclose or suggest any such cost determination of a content object, claims 1, 9 and 17 are not anticipated by Dedrick. Consequently, dependent claims 2-8, 10-16, and 18-27 are not anticipated by Dedrick.

2.   **Claims 3-6, 11-14, 19-22 and 25-27 are patentable over Dedrick**

Claims 3-6, 11-14, 19-22 and 25-27 have been rejected under 35 U.S.C. § 103(a) as being

unpatentable over Dedrick.

Claims 3-6, 11-14, 19-22 and 25-27

Claims 3-6, 11-14, 19-22 and 25-27 should be deemed patentable by virtue of their

dependency to claims 1, 9, and 17 for at least the reasons set forth above. Since Dedrick does

not even teach the elements of claims 1, 9 and 17, the elements of dependent claims 3-6, 11-14,

19-22 and 25-27 are not made obvious in view of Dedrick.

3.   **Claims 7-8, 15-16 and 23-24 are patentable over Dedrick in view of Khan**

Claims 7-8, 15-16 and 23-24 have been rejected under 35 U.S.C. § 103(a) as being

unpatentable over Dedrick in view of Khan et al.

Claims 7-8, 15-16 and 23-24

Claims 7-8, 15-16 and 23-24 should be deemed patentable by virtue of their dependency

to claims 1, 9, and 17 for at least the reasons set forth above.   Moreover, Khan does not cure the

deficiencies of Dedrick.

Khan is directed to a system and method for computing costs associated with Internet

based content delivery.   In particular, Khan is directed to a system and method of charging users

for the sending of e-mails similar to the system used by the United States Postal Service of

charging users for the sending of regular mail. A cost is computed according to the transmission

of user specified data files. See Khan claim 1. At no point does Khan disclose determining a

content count for a content object, as recited in Appellant's claim 1.
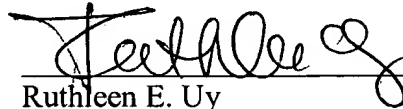
VIII.   CONCLUSION

Unless a check is submitted herewith for the fee required under 37 C.F.R. §41.37(a) and

1.17(c), please charge said fee to Deposit Account No. 19-4880.

The USPTO is directed and authorized to charge all required fees, except for the Issue

Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any

overpayments to said Deposit Account.

Respectfully submitted,

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Date: August 2, 2005

CLAIMS APPENDIX

CLAIMS 1-27 ON APPEAL:

1.   A method for determining the cost of a content object having a plurality of content entities, comprising the steps of:

determining a content count for the content object; and

determining from the content count a price for the content object.

2.   The method of claim 1, wherein the step of determining a content count further comprises the steps of determining a content count for each content entity, and summing the entity content counts to obtain a content count for the content object.

3.   The method of claim 2, wherein the step of obtaining a content count for entities containing characters further comprises the step of determining a character count for the entity.

4.   The method of claim 3, wherein the step of obtaining a content count further comprises the step of determining a page count from the character count.

5.   The method of claim 3, wherein the step of obtaining a character count further comprises at least one of:

counting the number of content characters in the content entity; and

determining the content entity type, and determining an average character count for content entities of that type.

6.   The method of claim 4, wherein the step of determining a content object price further comprises multiplying the page count with a predetermined price per page value.

7.   The method of claim 1, wherein at least one of the content entities comprises user-provided content, and wherein determining a price for the content object further comprises the steps of separately determining a price for user provided content and summing it with the price determined for the remaining content entities of the content object.

8.   The method of claim 7, wherein the price for user-provided material is determined in a first manner if the content count exceeds a predefined content count maximum, and is determined in a second manner if the content count does not exceed the predefined maximum.

9.   A program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine to perform method steps for determining the cost of a content object having a plurality of content entities, comprising the steps of:

determining a content count for the content object; and

determining from the content count a price for the content object.

10.   The method of claim 9, wherein the step of determining a content count further comprises the steps of determining a content count for each content entity, and summing the entity content counts to obtain a content count for the content object.

11.   The method of claim 10, wherein the step of obtaining a content count for entities containing characters further comprises the step of determining a character count for the entity.

12.   The method of claim 11, wherein the step of obtaining a content count further comprises the step of determining a page count from the character count.

13.   The method of claim 11, wherein the step of obtaining a character count further comprises at least one of:

counting the number of content characters in the content entity; and

determining the content entity type, and determining an average character count for content entities of that type.

14.   The method of claim 12, wherein the step of determining a content object price further comprises the step of multiplying the page count with a predetermined price per page value.

15.   The method of claim 9, wherein at least one of the content entities comprises user-provided content, and wherein the step of determining a price for the content object further comprises the steps of separately determining a price for user provided content and summing it with the price determined for the remaining content entities of the content object.

16.   The method of claim 15, wherein the price for user-provided material is determined in a first manner if the content count exceeds a predefined content count maximum, and is determined in a second manner of the content count does not exceed the predefined maximum.

17.   A system for determining the cost of a content object having a plurality of content entities, comprising:

means for determining a content count for the content object; and

means for determining a price for the content object from the content count.

18.   The system of claim 17, wherein the means for determining a content count further comprises means for determining a content count for each content entity, and means for summing the entity content counts to obtain a content count for the content object.

19.   The system of claim 18, wherein the means for obtaining a content count for entities containing characters further comprises means for determining a character count for the entity.

20.   The system of claim 19, wherein the means for obtaining a content count further comprises means for determining a page count from the character count.

21.   The system of claim 19, wherein the means for obtaining a character count further comprises at least one of a) means for counting the number of content characters in the content entity; and b) means for determining the content entity type, and means for determining an average character count for content entities of that type.

22.   The system of claim 20, wherein the means for determining a content object price further comprises means for multiplying the page count with a predetermined price per page value.

23.   The system of claim 17, wherein at least one of the content entities comprises user-provided content, and wherein the means for determining a price for the content object further comprises means for separately determining a price for user provided content and means for summing the separately determined price with the price determined for the remaining content entities of the content object.

24.   The system of claim 23, wherein the price for user-provided material is determined in a first manner if the content count exceeds a predefined content count maximum, and is determined in a second manner if the content count does not exceed the predefined maximum.

25.   A method for determining the cost of a content object having a plurality of content entities according to claim 1, wherein said content object comprises an electronic book created by a user and wherein said electronic book comprises a plurality of content entities selected by the user.

26.   A program storage device readable by a machine according to claim 9, wherein said content object comprises an electronic book created by a user and wherein said electronic book comprises a plurality of content entities selected by the user.

27.   A system for determining the cost of a content object having a plurality of content entities according to claim 17, wherein said content object comprises an electronic book created by a user and wherein said electronic book comprises a plurality of content entities selected by the user.

EVIDENCE APPENDIX:

None.

RELATED PROCEEDINGS APPENDIX

None.